



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/617,380	07/17/2000	DAVID J. OTWAY	CTX-052-(154	8636

959 7590 06/02/2005

LAHIVE & COCKFIELD, LLP.
28 STATE STREET
BOSTON, MA 02109

EXAMINER

HENEGHAN, MATTHEW E

ART UNIT	PAPER NUMBER
----------	--------------

2134

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/617,380

Applicant(s)

OTWAY ET AL.

Examiner

Matthew Heneghan

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) 49-71 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-20 and 30-48 is/are allowed.
- 6) ☒ Claim(s) 21-24 is/are rejected.
- 7) ☒ Claim(s) 25-29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/28/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1, 3, 11, 17, 21, 27, and 29 have been amended. Claims 1-48 have been examined.
2. Claims 49-71 are previously withdrawn due to the previous restriction requirement.

Information Disclosure Statement

3. Items C16, C17, and C19 in the IDS filed 28 February 2005 were illegible and not considered. All other items in the IDS have been considered.

Specification

4. In view of Applicant's amended abstract, all previous objections are withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2134

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,553,139 to Ross et al. (hereinafter "Ross I") and U.S. Patent No. 5,553,143 to Ross et al. (hereinafter "Ross II").

Ross I discloses a distribution system for distributing software licenses. Ross I includes an embodiment wherein the licenses distributed are those disclosed in Ross II (see Ross I, column 3, lines 6-13; Ross II was filed as Application 08/192,166). Ross I transmits a license that includes key information (the first key) sent in a header (see Ross II, column 17, lines 31-42), where the license is encrypted using an enabler key (the second key). The enabler key is also transmitted in encrypted form to an extractor, which extracts the enabler key and subsequently transmits it to an installer (see Ross I, column 3, lines 14-44).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2134

6. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,553,139 to Ross et al. (hereinafter "Ross I") and U.S. Patent No. 5,553,143 to Ross et al. (hereinafter "Ross II"). as applied to claim 21 above, and further in view of Schneier, "Applied Cryptography," 1996, p.48.

Ross I and Ross II do not disclose the key protocol used in encrypting the enabler key being sent to the extractor.

Schneier disclose the use of public key algorithms for key exchanging , and further suggests that this allow a system ("Alice") to send a secure message to another system ("Bob"), even if he has never heard of her.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to send the enabler key using a public key, as disclosed by Schneier, as this allows the system to send a key, even if the recipient has never heard of the sender. -

Allowable Subject Matter

7. Claims 1-20 and 30-48 are allowed.

8. Claims 25-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is an examiner's statement of reasons for allowance:

Regarding all of the independent claims and dependent claim 25, the claims are allowable for the reasons given with respect to claim 1 in the previous office action.

All other claims are allowable based upon their dependence on allowable claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

10. Applicant's arguments, see Remarks, filed 24 February 2005, with respect to all of the rejections under 35 U.S.C. 112, second paragraph have been fully considered and are persuasive in view of Applicant's amendments. The rejections under 35 U.S.C. 112, second paragraph of the claims have been withdrawn.

11. Applicant's arguments, see Remarks, filed 24 February 2005, with respect to the rejection under 35 U.S.C. 102 of claim 17 have been fully considered and are persuasive in view of Applicant's amendments. The rejection of claim 17 has been withdrawn.

Art Unit: 2134

12. Applicant's arguments filed 24 February 2005 regarding the rejections of claims 21-24 under 35 U.S.C. 102 and 35 U.S.C. 103 have been fully considered but they are not persuasive. The keys are sent in encrypted form to the third device (the extractor/installer), thus anticipating the limitations.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

Art Unit: 2134

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached at (571) 272-3838.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:


(703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MEH

May 31, 2005


GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGICAL SERVICES